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United States Patent and Trademark Office ATTN: Examiner Shin-Lin Chen Art Unit: 1632	(703) 305-1678	(703) 308-4242

From : Stacy L. Taylor**Date :** May 27, 2003**Client/Matter No :** 041673-2045**User ID No :** 3054**FAX RECEIVED****MAY 28 2003****GROUP 1600****MESSAGE:**

Applicant: Mark Tuszynski
Title: MUTANT PRO-NEUROTROPHIN WITH
IMPROVED ACTIVITY

Appl. No.: 09/788,188**Filing Date:** 02/16/2001**CONFIDENTIAL**

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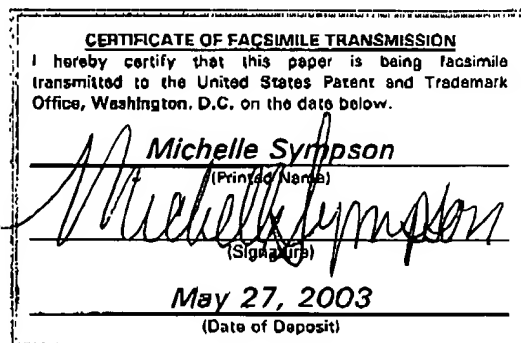
Michelle Sympson

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Atty. Dkt. No. 041673-2045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Tuszynski, *et al.*
Title: MUTANT PRO-NEUROTROPHIN
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Examiner: Chen, Shin-Lin
Art Unit: 1632



TRANSMITTAL RE FURTHER SUPPLEMENTAL RESPONSE
TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed herewith please find Further Supplemental Response to Restriction Requirement (2 pages).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.18, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Respectfully submitted,

Date 5-27-03
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By Stacy L. Taylor
Stacy L. Taylor
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Registration No. 34,842

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CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Washington, D.C. on the date below. <u>Michelle Sympson</u> (Printed Name) <u><i>Michelle Sympson</i></u> (Signature) <u>May 27, 2003</u> (Date of Deposit)

FURTHER SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Arlington, Virginia 22313-1450

Sir:

This is in further response to a restriction requirement set forth in this application, and maintained in the Office Action of May 5, 2003.

In the Action, the Examiner has maintained the requirement for election of one of SEQ.ID Nos. 2, 4, 6 and 8 for examination. Subject to a *provisional* election of the species encompassing claims to a mutant NGF polypeptide; e.g., of SEQ. ID No. 2, Applicants respectfully maintain their traversal of the requirement on the following bases:

(1) Claim 9 confirms that SEQ.ID. Nos. 2, 4, 6 and 8 are claimed as a Markush group of alternative polypeptides. As discussed in MPEP §803.02, restriction *cannot be required* between members of a Markush grouping. The maintenance of the present restriction requirement is at odds with the restrictions imposed by §803.02.

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(2) Assuming that the restriction between SEQ. ID Nos. 2, 4, 6 and 8 would comprise an election of species, as generally permitted under §803.02, the requirement for species election would still not be proper.

First, as previously noted, a species election is only appropriate as between members of a Markush grouping if "two or more members [of the Markush group] are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 25 U.S.C. 103 with respect to the other member(s)." MPEP §803.02, third paragraph. Here, however, the mutant polypeptides of Claims 1-10 (elected Group I) all contain the ~~same~~ N-glycosylation sequence and the ~~same~~ kind of mutation in that sequence, as described. It must be appreciated that the claims do not turn on the structure of any native neurotrophins (NGF, NT3, etc.), but only a specific mutation sequence contained in each or any of them. Patentability therefore turns on a single sequence and, to that extent, SEQ. ID. Nos. 2, 4, 6 and 8 are not "unrelated and diverse" within the meaning of §803.02, third paragraph.

Second, even if the patentability of the claims could be read as turning on the novelty and non-obviousness of diverse and unrelated sequences, the 1996 examination guidelines provide for up to 10 such sequences to be examined in a single application ("It has been determined that normally ten sequences constitute a reasonable number for examination purposes.").

For all of the foregoing reasons, withdrawal of the further restriction requirement between the polypeptides/SEQ.ID. Nos. of Group I is respectfully requested. Examination of Claims 1-10, and favorable consideration thereof, is also requested.

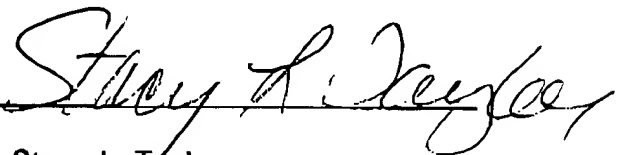
Respectfully submitted,

Date

5-23-03

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